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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,437	01/18/2005	Franco Burco	NOTAR-019US	3675

7663 7590 03/23/2007  
STETINA BRUNDA GARRED & BRUCKER  
75 ENTERPRISE, SUITE 250  
ALISO VIEJO, CA 92656

EXAMINER
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SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3725

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/522,437

Applicant(s)

BURCO ET AL.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,12 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,12 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the claims provides for a method performed in a sequential order, however the first claimed step is "performing a second rolling passage in said two-high edging stand" which is then followed by the step of performing a first and second rolling passage in a second universal stand and then back to a second rolling passage in the two-high edging stand, eventually followed by a third passage in the edging stand. Therefore the sequencing of the claimed steps is not clear since there are several second rolling passages in the edging stand.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 17, the negative limitation of "without interposition of further rolling stands" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure does not state that there may be no interposition of further rolling stands and therefore is considered new matter.

The remainder of the office action considers the claims as best understood.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al '597 in view of Noda '213, Engel '799 and Kishikawa et al '699. As set forth in the a previous Office action it would have been obvious to one skilled in the art

to space the compact intermediate rolling group of Muller et al. such that the entire stock bar is acted on simultaneously by all three stands and a finishing stand is located at a distance from the compact group such that the bar is processed in that stand independently of the compact group, following the suggestion of Noda, in order to avoid excessive cooling, and find optimum pass schedules for any specific rolling conditions and desired product characteristics. It would have further been obvious to employ a conventional edging stand (two-high stand A2 shown in Figure 1) of Noda in the compact group of Muller et al as such modification would be an obvious expedient to one skilled in the art, depending on the final product desired and costs involved.

The claims further recite a first reduction ratio between 10 and 30% and a second reduction ration between 3 and 25%, with the first reduction ratio being larger than the second. Kishikawa et al. shows that reduction ratios in these ranges are conventional in rail rolling. See Tables I and II. Engel et al. discloses rail rolling such as that of the invention, and advises that the reduction ratio in the first universal stand should be greater than that in the second universal stand in order to reduce the wear of the second stand and, consequently, produce acceptable rolled products for a longer time. See column 3, lines 32 to 61 and Claim 5. To employ such knowledge, shown to be clearly present in the art, in the rolling of Muller et al. would be an obvious expedient to the ordinarily skilled practitioner in order to optimize the production of the facility.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over IDS citation JP03-86301 (Kubota hereafter) in view of Noda. Figure 7 of Kubota discloses a

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rolling plant having the stands required by these claims. Kubota does not mention the spacing of the stands. Noda discloses a rail rolling arrangement having a compact intermediate group and a finishing stand, and advises that, advantageously, the stands of the intermediate group should be spaced such that the bar being rolled is simultaneously engaged by all three of the roll stands, and the finishing stand should be spaced from the intermediate group by a sufficient distance that bars can be finish rolled independently of the intermediate group rolling. See column 2, lines 58 to 67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to space the intermediate and finishing stands of Kubota Figure 7 such that a bar is simultaneously contacted by all three of the stands of the intermediate group and the finishing stand separated from the intermediate group to allow its use independently, following the suggestion of Noda, in order to increase the efficiency of the plant in rolling various products.

### ***Response to Arguments***

Applicant's arguments filed 12/13/2006 have been fully considered but they are not persuasive. Applicants argue that there is no motivation to incorporate a two high edging mill of Noda in place of the upsetting stand of Muller. In response the examiner points out that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is known in the art that production of various material, such as rails may utilize a variety of intermediate compact group set ups including the use of upsetting stands and edging stands with each having well known advantages over the other and the selection of either of the two known stands would have been obvious depending on the product to be produced and the costs associated with the production of the product.

It should be noted that applicants have not provided any arguments with respect to the rejection of claim 17 under the combination of Kubota and Noda references and therefore the rejection is maintained as stated in the previous Office Actions.

### ***Conclusion***

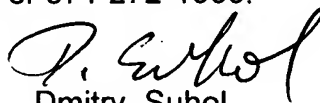
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Dmitry Suhol  
Primary Examiner  
Art Unit 3725

DS.